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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/758,357

01/15/2004

Shalaby W. Shalaby

SHA-49

5302

29698

7590

05/17/2006

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EXAMINER

ROGERS, JAMES WILLIAM

ART UNIT

PAPER NUMBER

1618

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/758,357		SHALABY, SHALABY W.	
	<b>Examiner</b>		<b>Art Unit</b>	
	James W. Rogers		1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 11-15 been renumbered 10-14.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3,10-14, drawn to an injectable polymeric composition comprising a non-aqueous liquid comprising a segmented block copolymer comprising ether and peptide chain sequences, classified in class 424, subclass 78.100.
- II. Claims 1,4,5 and 10-14, drawn to an injectable polymeric composition comprising a liquid succinic anhydride-bearing polyether and liquid diamine capable of crosslinking in-situ to form an amide-crosslinked network, classified in class 424, subclass 78.21.
- III. Claim 1,6 and 10-14, drawn to an injectable polymeric composition comprising the step of mixing a solution of succinic anhydride bearing polyvinylpyrrolidone in liquid succinic anhydride-bearing polyalkylene glycol with a reactive diamine or polyoxyalkylene diamine capable of

forming an amide crosslinked network, classified in class 424, subclass 78.24.

- IV. Claim 1,7 and 10-14, drawn to an injectable polymeric composition comprising liquid urethane interlinked polyether glycol capped with isocyanate end-groups, classified in class 424, subclass 78.37.
- V. Claim 1,8 and 10-14, drawn to an injectable polymeric composition comprising a liquid polyether glycol capped with itaconic half-ester end groups and a redox free-radical initiator system comprising a combination of ascorbic acid and potassium persulfate, classified in class 424, subclass 78.12.
- VI. Claim 1,9 and 10-14, drawn to an injectable polymeric composition comprising a dispersion of surface-maleated polypropylene microfibers and amine-terminated polyethylene glycol capable of forming a fiber-reinforced network in an aqueous environment, wherein the fibers are covalently linked to the polyethylene glycol-based matrix, classified in class 424, subclass 78.11.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-VI are related as products which share an alleged common utility of an injectable polymeric composition comprising a non-aqueous liquid that forms a non-absorbable hydrogel upon contact with an aqueous environment but the common utility is not linked to a substantial structural feature. The products in this relationship are distinct if either or both of the following can be shown: (1) that the products encompass

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embodiments that are not required to perform the common utility or (2) that the products as claimed can be used to perform another utility. In this case, the above products encompass embodiments that are not required to perform the common utility. For instance invention I is made by the process of end-grafting amine-terminated polyether with  $\epsilon$ -caprolactam not required in invention II-VI. Invention II requires a liquid succinic anhydride-bearing polyether and liquid diamine capable of crosslinking in-situ to form and amide-crosslinked network not required in inventions I,III-VI. Invention III requires polyvinylpyrrolidone in the polymer chain not required in inventions I-II,IV-VI. Invention IV requires the polyether be end capped with isocyanate end-groups not required in inventions I-III,V,VI. Invention V requires itaconic half-ester end-groups and a redox free-radical initiator system comprising a combination of ascorbic acid and potassium persulfate not required in inventions I-IV and VI. Invention VI requires a dispersion of surface-maleated polypropylene microfibers capable of forming a fiber-reinforced network in an aqueous environment with amine-terminated polyethylene glycol, not required in inventions I-V.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

The election of an invention and/or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

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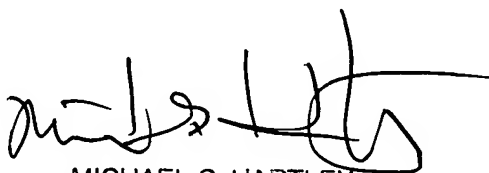
Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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MICHAEL G. HARTLEY  
SUPERVISORY PATENT EXAMINER